

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

FEB 24 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HELMUT FITZ and KLAUS BRUSTLE

Appeal No. 2005-2135
Application No. 10/038,910

ON BRIEF

Before McQUADE, NASE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 22, 33-35, 42, 43, 45 and 47-50. Claims 23-32, 37-41 and 44 stand withdrawn from consideration as not being directed to an elected species or invention and claims 36 and 46 have been objected to as depending from a rejected claim but are otherwise indicated as allowable. Subsequent to the filing of this appeal, claim 34 was re-written in independent form in an amendment filed February 17, 2005.

BACKGROUND

The appellants' invention relates to a braking and damping device having a fluid cylinder in which two pistons are arranged in a linearly displaceable manner, wherein a piston is displaceable over a piston rod (appellants' specification, page 1). The appellants' device is particularly designed for use with furniture having moving parts, such as drawers and doors. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The Evidence of Anticipation and Obviousness

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

| | | |
|----------------------------|--------------|--------------|
| Smalley | 3,904,226 | Sep. 9, 1975 |
| Corcoran et al. (Corcoran) | 5,257,680 | Nov. 2, 1993 |
| Muller | 2002/0066629 | Jun. 6. 2002 |
| Beyene et al. (Beyene) | 6,443,437 | Sep. 3, 2002 |

The Rejections

The following rejections are before us for review.

Claims 22, 33-35, 43, 45 and 47-50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Smalley.

Claims 22, 33-35, 43, 45 and 47-50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Corcoran.

Claims 22, 33-35, 43, 45 and 47-50 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Beyene.

Claim 42 stands rejected under 35 U.S.C. § 103 as being unpatentable over Smalley, Corcoran or Beyene in view of Muller.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the non-final rejection (mailed April 2, 2004) and answer (mailed December 17, 2004) for the examiner's complete reasoning in support of the rejections and to the brief¹ (filed August 2, 2004) and reply brief (filed February 17, 2005) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejections based on Beyene

The rejection of claims 22, 33-35, 43, 45 and 47-50 as being anticipated by Beyene will not be sustained. For the reasons articulated by appellants on page 12 of

¹ Appellants' "REQUEST FOR REINSTATEMENT OF APPEAL" filed August 2, 2004 is referred to herein as appellants' brief.

the brief, the subject matter of these claims is not anticipated by Beyene. As explained by appellants, tube 22 cannot be considered the fluid cylinder recited in appellants' claims because top end plate 26, relied on by the examiner as one of the two recited pistons, would not be linearly displaceable in the fluid cylinder as required by the claims, as end plate 26 is fixed with respect to tube 22. On the other hand, considering bottom tube 32 to be the fluid cylinder, spring elements 50A, relied on by the examiner as the recited elastically deformable sealing member, are not pressed against the wall of tube 32 and thus would not meet the claimed limitation that the deformable sealing member be pressed against the cylinder wall.

The examiner's application of Muller does nothing to make up for the deficiencies of Beyene discussed above. It follows that the rejection of claim 42 as being unpatentable over Beyene in view of Muller also cannot be sustained.

The rejections based on Smalley

With respect to claim 22, appellants argue that Smalley lacks a fluid cylinder and that, thus, washers 18, 19a are not pistons and bushing 21 is a damping member and not a sealing member. Specifically, as explained on page 5 of their brief, appellants urge that a fluid cylinder is "a cylindrical body or space that forms a chamber in which a piston or similar element can work on a fluid." Appellants have not cogently explained, nor is it apparent to us, why Smalley's tubular housing 6 falls short of meeting this definition of "fluid cylinder" or why the washers 18, 19a and bushing 21 are not pistons

and an elastically deformable sealing member (note the compression of bushing 21 against the tubular housing in Figure 5), respectively, notwithstanding that Smalley does not expressly refer to these elements as such. While anticipation requires the disclosure of each and every limitation of the claim at issue in a single prior art reference, it does not require such disclosure *in haec verba*. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). In addition, it does not require that the prior art reference "teach" what the application at issue teaches. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)..

Appellants also argue, with respect to claim 22, that Smalley's bushing 21 is squeezed between linearly moveable washer 18 and load transfer element 10, which is fastened by welding or the like to the housing 6 and thus is not linearly displaceable in the fluid cylinder as claim 22 requires the pistons to be, and not between two pistons (brief, pages 6-7). As pointed out by the examiner on page 4 of the answer, although the load transfer element 10 assists in squeezing the bushings, the squeezing still takes place between the two washers 18, 19a. Appellants' argument is thus not well taken.

For the reasons discussed above, appellants' arguments do not persuade us of any error on the part of the examiner in rejecting claim 22 as being anticipated by Smalley. The rejection of claim 22, as well as claim 33² which appellants have not argued separately apart from claim 22, is sustained.

The rejection of claims 34, 35, 43, 45 and 47-50 as being anticipated by Smalley is reversed. With respect to claim 34, there is no indication in Smalley that bushing 22 is a seal which seals with the wall of the housing (cylinder) 6, as called for in claim 34. With respect to claim 35, Smalley lacks a solid body made of rubber elastic material that connects the two pistons. Specifically, the two washers 18, 19a are separated not by a solid body but by three distinct bodies (the two polyurethane bushings 21, 22 and washer-like load transfer element 10), none of which is made of rubber elastic material. With respect to claim 43, and claims 45 and 47-50 depending from claim 43, there is no indication in Smalley that there is any fluid damping.

We also shall not sustain the rejection of claim 42 as being unpatentable over Smalley in view of Muller. Simply stated, we agree with appellants (brief, page 8) that Muller's teaching with regard to the use of friction-based braking and damping elements with furniture/cabinets, especially drawers and furniture/cabinet drawers, provides no suggestion whatsoever to mount the vehicle hitch of Smalley on a piece of furniture.

² It is not clear why claim 33, which depends from claim 32, withdrawn from consideration, was not also withdrawn from consideration, but that issue is not within our jurisdiction.

The rejections based on Corcoran

With respect to claim 22, appellants argue that Corcoran's washers 22 cannot be considered pistons, because they are part of a single device (washers 22 and piston 12) that forms a piston (brief, page 10). We, like appellants, observe that Corcoran refers to element 12 as a piston and elements 22 as washers and, further, that washers 22 move in unison with piston 12. Nevertheless, as mentioned above, anticipation does not require disclosure of the claim limitations *in haec verba*. Bode, 550 F.2d at 660, 193 USPQ at 16. Furthermore, there is no requirement in claim 22 that the pistons be moveable relative to one another. As such, we find no error in the examiner's position that the washers 22 of Corcoran respond to the pistons of claim 22.

Appellants' argument on pages 10-11 of the brief that the polymeric sleeve 14 forms part of the piston itself and thus is not a separate sealing member squeezed between two pistons is likewise not well taken. While the sleeve 14 forms part of the structure which Corcoran refers to as a "piston," it is a separate element distinct from the washers 22, which respond structurally to the pistons recited in claim 22.

In light of the above, we shall sustain the rejection of claim 22 as being anticipated by Corcoran. We shall also sustain the rejection of claims 33 and 35, which appellants have not argued separately from claim 22.

We shall not sustain the rejection of claims 34, 43, 45 and 47-50 as being anticipated by Corcoran, however. The examiner's insinuation (answer, page 7) that plastic or metal bushing 16 is a sealing member is unsound.

We also cannot sustain the rejection of claim 42 as being unpatentable over Corcoran in view of Muller. While Corcoran discloses that the combination of friction damping with hysteresis damping makes the surface effect damper disclosed therein better suited for a variety of applications, the particular examples cited therein, i.e., motor mounts, shock absorbers, vehicle engine dampers, helicopter strut dampers, etc., are so dissimilar from the application of furniture doors and drawers addressed by Muller that one of ordinary skill in the art would have found no suggestion in Muller to mount the damper of Corcoran to a piece of furniture as called for in claim 42.

STATEMENT PURSUANT TO 37 CFR § 41.50(c)

Pursuant to 37 CFR § 41.50(c), we point out that the rejections of claims 22, 33 and 35 as being anticipated by either Smalley or Corcoran, sustained herein for the reasons discussed above, may be overcome by amending independent claim 22 to recite that the two pistons are arranged so as to be linearly displaceable relative to one another in said fluid cylinder and by inserting "by said displacement of said one of said two pistons relative to the other of said two pistons" after "pistons" (last occurrence) in the final paragraph of claim 22.

CONCLUSION

To summarize, the examiner's rejection of claims 22, 33-35, 43, 45 and 47-50 as being anticipated by Beyene and the rejections of claim 42 as being unpatentable over Smalley, Corcoran or Beyene in view of Muller are reversed. The rejection of claims 22, 33-35, 43, 45 and 47-50 as being anticipated by Smalley is affirmed as to claims 22

and 33 and reversed as to claims 34, 35, 43, 45 and 47-50. The rejection of claims 22, 33-35, 43, 45 and 47-50 as being anticipated by Corcoran is affirmed as to claims 22, 33 and 35 and reversed as to claims 34, 43, 45 and 47-50. A statement under 37 CFR § 41.50(c) as to how independent claim 22 may be amended to overcome the rejections of claims 22, 33 and 35 is included in this decision.

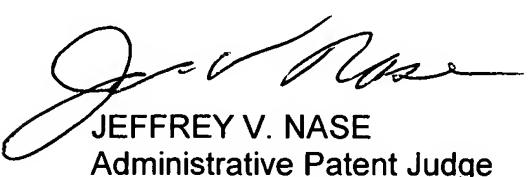
No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; STATEMENT UNDER 37 CFR § 41.50(c)



JOHN P. McQUADE
Administrative Patent Judge

)
)
)
)
)
)
)
)
BOARD OF PATENT
APPEALS
AND
INTERFERENCES



JEFFREY V. NASE
Administrative Patent Judge

)
)
)
)
)
BOARD OF PATENT
APPEALS
AND
INTERFERENCES



JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)

WENDEROTH, LIND & PONACK, LLP
2033 K STREET NW
SUITE 800
WASHINGTON, DC 20006-1021

JDB/ki